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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER, and WILL GARDENSWARTZ

Appeal 2009-009673
Application 09/505,632
Technology Center 3600

Before: HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FISCHETTI, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

Appellants have filed a second Request for Rehearing under 35 U.S.C. § 41.52(a)(1) of the Decision on Rehearing (granting Appellants' Request of Rehearing to the extent that the grounds of rejection of claim 24 the Board affirmed was deemed a new grounds).

1. Appellants filed an Appeal Brief on January 29, 2007 and a Reply Brief on March 25, 2008.
2. Our Decision on Appeal ("Decision") was mailed March 11, 2011.
3. Appellants entered a Request for Rehearing ("First Request") on March 11, 2011.
4. Our Decision on Rehearing ("First Rehearing Decision"), in response to the First Request, was mailed July 1, 2011.
5. Appellants entered another Request for Rehearing of the First Rehearing Decision ("Second Request") on July 30, 2011.
6. Our Decision affirmed the Examiner's rejection of claims 24-27, 36-39, 48, and 49 under 35 U.S.C. § 103(a) over Jovicic (Decision 5-8).
7. Our Decision affirmed the Examiner's rejection of claims 28-31 and 40-43 under 35 U.S.C. § 103(a) over Jovicic, under the same reasoning as that applied to claim 24 (Decision 8).
8. Our Decision, at "FF 5," found that Jovicic discloses an Internet Coupon Server that responds directly to a consumer's requests for a coupon, stating, "[d]uring an on-line connection between an Internet node and the Internet Coupon Server, the Internet coupon server accepts coupon selection from a user, and then transmits the unique Internet coupon back to the user's printing device or user's electronic mail storage device." ([Jovicic] Col. 3[,], 11. 30-34)."

9. Appellants' First Request presented no arguments directed to any claim other than claim 24.
10. Our First Rehearing Decision re-affirmed the Examiner's rejection of claim 24 under 35 U.S.C. § 103(a) over Jovicic (First Rehearing Decision 7).
11. Our First Rehearing Decision granted Appellants' request to designate the grounds of rejection of the Board's Decision, affirming the rejection of claim 24, as a new grounds of rejection under § 41.50(b) (First Rehearing Decision 7).

Response to Appellants' Second Request for Rehearing

Appellants' Second Request for Rehearing presents arguments directed to two independent claim groups: claims 24, 36, and 48; and claims 28, 40, and 49. We therefore confine our present Decision on Reconsideration to only those claims to which Appellants have asserted error in Appellants' Second Request for Rehearing.

We Grant Appellants' Second Request for Rehearing insofar as it is directed to claims 24-27, 36-39, and 48, in that the 35 U.S.C. § 103(a) rejection of these claims is not sustained on reconsideration.

We Deny Appellants' Second Request for Rehearing insofar as it is directed to claims 28-31, 40-43, and 49, in that the 35 U.S.C. § 103(a) rejection of these claims is sustained on reconsideration.

Appellants argue, as to both claim groups, the "new rationale in the 7/1/2011 decision alleges that co-locating versus physically separating web sites, and location of code modules are implementation details, suggesting that such modifications provide no patentable distinction." (Second Request 7, 9).

We disagree, because our analysis was not based on “co-locating” or “physically separating.” Instead, we construed the phrase in claim 24, *in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer*, to mean: “that the manufacturer's web site and the remote web site may be two instances of web sites situated in one computer that communicate with each other locally. We therefore find that Jovicic discloses the claim limitations of the manufacturer's web site and the remote web site at its Internet Coupon Server (FF 1, 2, 5).” (Decision 7).

In the face of these findings, Appellants nevertheless assert as to both groups of claims, that the rejection maps the Internet Coupon Notification Center 134 (ICNC) in Jovicic to the claimed “remote Web site.” (Second Request 6, 8).

This is a mischaracterization of our analysis. As is clear from our findings, our analysis did not rely on the ICNC 134 in Jovicic to disclose, *in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer*. Rather, our Decision reads Jovicic's Internet Node PC 122 as meeting the claimed user computer, and reads the Internet Coupon Server (ICS) 124, and *not* the ICNC 134, of Jovicic as having the requisite functions to meet those of both the manufacturer/retailer web site *and* the remote web site RWS. (Decision 7).

Claims 24-27, 36-39, and 48

Representative independent claim 24 recites:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

Appellants argue “Jovicic fails to disclose the ICNC responding to receipt of region data received by the ICS.” (Second Request 8).

Upon further consideration, we find that even reading the ICS in Jovicic as providing the functions of both the remote and manufacturer's web sites, claim 24 requires such a server to take in a request and, in response, transmit a different type of data, specifically “region data,” to the remote web site. Therefore, because of this distinction, we find that the manufacturer's web site does more than just pass along a request to another web site. We therefore will not sustain the rejection of claim 24. Since claims 25-27 depend from claim 24, and since we will not sustain the rejection of claim 24, the rejection of claims 25-27 likewise will not be sustained.

We find the requirements of independent claims 36 and 48 mirror the requirements of claim 24, but in the form of system and medium claims instead of a method. Since these independent claims also require *region data*, the same reasoning applies to these claims, and we will not sustain

their rejections. Since claims 37-39 depend from claim 36, and since we will not sustain the rejection of claim 36, the rejection of claims 37-39 likewise will not be sustained.

Claims 28-31, 40-43, and 49

Appellants argue independent claims 28, 40, and 49 together as a group. (Second Request 9).

Representative independent claim 28 recites:

28. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

Claim 28 thus recites the following required components:

- A consumer computer (“CC”)
- A Web site of a retailer (“RetWS”)
- A remote web site (“RWS”)

Claim 28 requires the components to perform steps in the following order:

1. CC transmits a request to RetWS
2. in response to receipt of request, RetWS transmits it to RWS
3. in response to receipt of request, RWS transmits incentives to RetWS

4. in response to receipt of incentives, RWS transmits them to CC

Initially, we note that representative claim 28 does not require *region data*, but only moves a request between the consumer computer CC, the retailer web site RetWS, and the remote web site RWS. As such, claim 28 is broader in scope than claim 24.

A visual representation of these components and the transmitting process is shown below, with the process beginning at the top left, and ending at the bottom left:



Schematic diagram of the process flow of claim 28

Appellants argue Jovicic does not disclose the limitation *in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives*, because:

Jovicic fails to disclose the responsive nature of the transmission from the remote web site, regardless whether or not the remote web site is located on a physically remote server from the manufacturer web site. That is, Jovicic fails to disclose the ICNC responding to receipt of the request, as defined by claim 28. There is nothing in Jovicic or the art relied upon in the rejections to suggest the responsive nature noted above.

(Second Request 9).

We are not persuaded by Appellants' argument because Jovicic discloses an Internet Coupon Server that responds directly to a consumer's requests for a coupon. (FF 5). Here, Jovicic explicitly discloses “[d]uring

an on-line connection between an Internet node and the Internet Coupon Server, the Internet Coupon Server accepts coupon selection from a user, and then transmits the unique Internet coupon back to the user's printing device or user's electronic mail storage device.' ([Jovicic] Col. 3[.] 11. 30-34).” (Decision 5).

While Jovicic’s implementation combines the receive/transmit, *i.e.*, forwarding, steps of the claimed RetWS with the steps of the RWS, into one “Internet Coupon Server,” we nevertheless find it would have been obvious to modify Jovicic by separating the work of the Internet Coupon Server into two servers, such that one merely forwards requests and responses, so that the work could be spread across multiple servers for purposes of increasing workload, performance, or availability.¹ This is particularly evident since

¹ Even though we are not required give an explanation of how Jovicic system would bodily incorporate such a change (*See In re Keller*, 642 F.2d 413, 425 (CCPA 1981)), we nevertheless note same as follows to underpin our finding of obviousness. One of ordinary skill in the art would recognize from Jovicic’s single Internet Coupon Server that it could be implemented with a front-end routing/workload-distributor web site system which hands work off to one or more back-end servers to handle the http requests (by returning incentives in response to the request). This would permit multiple back-end servers to operate behind a single web presence of the front-end server. Using multiple servers instead of a single server (either a single front-end and single back-end, or a single front-end and multiple back-end servers) may permit more total work to be handled, faster response time, or improved availability. The ordinary artisan would recognize an implementation using multiple web servers is old and well-known in web sites that must scale up to handle higher amounts of traffic than can be handled by a single server, such that improving Jovicic by similarly implementing on multiple web sites would be an obvious application of a known improvement to a new device.

It follows that the ordinary artisan would recognize that if you make an obvious modification to the Jovicic Internet Coupon Server implementation by implementing it on multiple web servers with a front-end

claim 28, unlike claim 24, requires passing through of only the same type of data between network points, namely *requests* are sent in one direction and *incentives* in the return direction. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”). (*See*, Decision 8, 9; First Rehearing Decision 3).

Appellants’ Late Introduction of New Facts

Finally, Appellants also attempt to introduce new “facts” into the record by asserting “[t]he appellant[s] note[] the following facts for purposes of court appeal. The BPAI panel need not review or comment on them, although they are welcome to do so.” (Second Request 10).

server and back-end server, you would need to insert additional communication steps between the front-end and back-end servers that are unnecessary when using a single web site/server. By splitting the work of the server into a front-end and back-end server, the front-end server becomes a “client” to the back-end “serve[r],” in the language of the client/server architecture of the Specification (Spec. 8:11-14). By inserting the extra server, the ordinary artisan would recognize those additionally necessary communication steps would be to have the front-end server transmit the request to the back-end server, and have the front-end server transmit the incentive to the requesting consumer computer. In adding those additional communication steps, the front-end/RetWS server would then act *in response to receipt of said request at [the back-end server/RWS], transmitting from said [back-end server/RWS] over the Internet to said [front-end server/RetWS] a list of manufacturer incentives*, thus meeting the disputed claim requirement. The improved implementation of Jovicic using a front-end/RetWS and back-end/RWS pair of web site servers, also meets the other “in response to” claim limitations, because of the responsive nature of the forwarding work done at the front-end and back-end servers.

Appellants nevertheless are seeking to have made of record at this late date definitions, and quotations asserted from the Specification and Jovicic. Appellants are attempting to introduce new evidence, but it is too late to do so. This new information was not presented by Appellants in their Brief, and thus will not be considered on reconsideration (Appeal Br. 10-13). “A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1331 (Fed. Cir. 1998) (citing *Moller v. Harding*, 214 USPQ 730, 731 (BPAI 1982), *aff’d*, 714 F.2d 160 (Fed. Cir. 1983) (table)). “Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.” 37 C.F.R. § 41.52(a)(1). *See, e.g., Ex parte Hindersinn*, 177 USPQ 78, 80 (BPAI 1971) (An argument advanced in a petition for reconsideration but not advanced in the principal brief or the reply brief was not properly before us); *cf. Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998) (citing cases supporting the proposition that issues not raised before the court are not addressed on rehearing).

CONCLUSION

For the reasons above, we are not convinced that Appellants have shown with particularity points believed to have been misapprehended or overlooked by the Board in rendering its earlier decisions as to claims 28-31, 40-43, and 49. Accordingly, Appellants’ Second Request for Rehearing insofar as Appellants seek an establishment error in the Decision of the Board and/or in its First Rehearing Decision is DENIED as to claims 28-31, 40-43, and 49.

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However, upon consideration of Appellants' Second Request for Rehearing, we reverse the rejection of claims 24-27, 36-39, and 48, and therefore GRANT the Second Request for Rehearing to the extent the Request covered claims 24-27, 36-39, and 48.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED-IN-PART

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